

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MK

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/110,145 07/02/98 EGGERT

D 14.281B

QM12/1021

EMRICH & DITHMAR
300 SOUTH WACKER DRIVE
SUITE 3000
CHICAGO IL 60606

EXAMINER

MEISLIN, D

ART UNIT	PAPER NUMBER
----------	--------------

3723

DATE MAILED:

10/21/99

Please find below and/or attached an Office communication concerning this application or proceeding.**Commissioner of Patents and Trademarks**

Office Action Summary	Application No.	Applicant(s)
	110145 Examiner Marsden	Eggers et al Group Art Unit 3703

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- Responsive to communication(s) filed on _____.
- This action is **FINAL**.
- Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 1 - 22 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- Claim(s) 1 - 14 is/are allowed.
- Claim(s) 15 - 22 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All Some* None of the CERTIFIED copies of the priority documents have been received.
- received in Application No. (Series Code/Serial Number) _____.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892
- Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Other _____

Office Action Summary

Art Unit: 3723

1. **The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.**

2. In the cases mentioned in Section 1.42 and 1.43, proof of the power or authority of the legal representative must be recorded in the Patent and Trademark Office or filed in the application before the grant of a patent. 409.01(b) Proof of Authority of Administrator or Executor (37 CFR 1.44)

Whenever because of the death of an inventor the right of applying for and obtaining a patent for an invention evolves upon an executor or administrator, or whenever an executor or administrator desires to intervene prior to the granting of a patent, proof of the authority of such executor or administrator should in all cases be made of record in the Patent and Trademark Office by filing in the application or recording in the assignment records a certificate of the clerk of a competent court or the register of wills that his or her appointment is still in full force and effect. Such certificate shall be signed by an officer and authenticated by the seal of the court by which the same was issued. The authority of other legal representatives of the inventor must be similarly established. If the certificate is not in the English language, an English translation is also required.

3. Claims 15-22 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the

Art Unit: 3723

present reissue is based. See *Hester Industries, Inc. V. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for patent cannot be recaptured by the filing of the present reissue application.

The limitation omitted in the reissue is “retaining member being generally bowl-shaped and convex toward said magnet, said retaining member and said inner end surface cooperating to retain said magnet therebetween”, and omission thereof is related to subject matter surrendered in the original application. The presence of the “retaining member being generally bowl-shaped and convex toward said magnet” limitation was added to the claims for the purpose of making the claims allowable over a rejection made in the application. The omitted limitation was argued in the original application to make the application claims allowable over a rejection in the application as set forth on page 3 of amendment “B”. The presence of the “retaining member and said inner end surface cooperating to retain said magnet therebetween” limitation was added to the claims in an attempt to make the claims allowable over a rejection made in the application and as argued on page 5 of amendment “A” to bring out a distinguishing aspect of the invention.

Art Unit: 3723

4. Claim 22 is rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent

is as follows: "continuous, closed, non-reentrant outer periphery". The original disclosure does not support such a limitation or a definition thereof.

5. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. Any inquiry concerning this communication should be directed to Examiner Meislin at (703) 308-3671.



D. S. Meislin
Primary Examiner
Group 3720, Art Unit 3723

October 20, 1999